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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,396	04/17/2001	John B. Ferber	08011.0134	6037

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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1300 I STREET, NW
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EXAMINER

YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,396

Applicant(s)

FERBER ET AL.

Examiner

John L Young

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

[Signature]
8-4-2004

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

NON-FINAL REJECTION

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

A prior Office action recites the substance of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action.

2. Claims 1-7 are rejected under 35 U.S.C. §103(a) as being obvious over Jovicic 5,855,007 (Dec. 29, 1998) (herein referred to as ("Jovicic").

As per independent claim 1, Jovicic (the ABSTRACT; FIG. 4; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) explicitly teaches an "electronic coupon."

Jovicic (the ABSTRACT; FIG. 4; FIG. 6; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) shows "A

method for providing electronic coupons, comprising: determining, at a user device information identifying a user; requesting, from a processor, an electronic coupon based on the information identifying the user . . . and displaying a redeemable representation of the at least one electronic coupon on the user device.”

Jovicic lacks an explicit recitation of “determining, at the processor, a profile of the user based on the information identifying the user; selecting, at the processor, at least one electronic coupon based on the determined profile of the user. . . .” even though Jovicic (FIG. 1; FIG. 3; FIG. 4; and FIG. 6) implicitly shows same.

It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Jovicic (FIG. 1; FIG. 3; FIG. 4; FIG. 6; the ABSTRACT; FIG. 4; FIG. 6; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) implicitly shows “determining, at the processor, a profile of the user based on the information identifying the user; selecting, at the processor, at least one electronic coupon based on the determined profile of the user. . . .” and it would have been obvious to modify and interpret the disclosure of Jovicic cited above as showing “determining, at the processor, a profile of the user based on the information identifying the user; selecting, at the processor, at least one electronic coupon based on the determined profile of the user. . . .” because modification and

interpretation of the cited disclosure of Jovicic would have provided *"a unique electronic redeemable coupon generating and redemption system and method using public computer networks such as the Internet, . . ."* (see Jovicic (col. 2, ll. 20-25)) based on the motivation to modify Jovicic *"whereby a consumer significantly decreases the amount of time and effort expended in locating, clipping and assembling of coupons. . ."* (see Jovicic (col. 2, ll. 20-40)).

As per claims 2-5, Jovicic shows the method of claim 1 and subsequent base claims depending from claim 1.

Jovicic (FIG. 1; FIG. 3; FIG. 4; FIG. 6; the ABSTRACT; FIG. 4; FIG. 6; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) implicitly shows all of the elements and limitations of claims 2-5.

Jovicic lacks an explicit recitation of some of the elements and limitations of claims 2-5, even though Jovicic (FIG. 1; FIG. 3; FIG. 4; FIG. 6; the ABSTRACT; FIG. 4; FIG. 6; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) implicitly shows same.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claims 2-5 were well known and expected in the art at the time of the invention. It would have been obvious at the time of the invention to a person of ordinary skill in the art that the disclosure of Jovicic (FIG. 1; FIG.

3; FIG. 4; FIG. 6; the ABSTRACT; FIG. 4; FIG. 6; FIG. 7; FIG. 9; col. 2, ll. 20-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 6, ll. 4-67; col. 7, ll. 20-67; col. 8, ll. 1-55; col. 9, ll. 10-38; col. 9, ll. 52-67; col. 10, ll. 1-67; and col. 11, ll. 1-40) implicitly shows the elements and limitations of claims 2-5, and it would have been obvious to modify and interpret the disclosure of Jovicic cited above as showing the elements and limitations of claims 2-5 because modification and interpretation of the cited disclosure of Jovicic would have provided “*a unique electronic redeemable coupon generating and redemption system and method using public computer networks such as the Internet, . . .*” (see Jovicic (col. 2, ll. 20-25)) based on the motivation to modify Jovicic “*whereby a consumer significantly decreases the amount of time and effort expended in locating, clipping and assembling of coupons. . . .*” (see Jovicic (col. 2, ll. 20-40)).

Independent claim 6 is rejected for substantially the same reasons as independent claim 1.

Independent claim 7 is rejected for substantially the same reasons as independent claim 1.

RESPONSE TO ARGUMENTS

3. Applicant's arguments (filed 04/29/2004) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons:

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Independent claim 6 is rejected for substantially the same reasons as independent claim 1.

Independent claim 7 is rejected for substantially the same reasons as independent claim 1.

RESPONSE TO ARGUMENTS

3. Applicant's arguments (filed 04/29/2004) concerning the rejections in the prior Office Action have been considered but are not persuasive for the following reasons: Applicant's arguments are moot pursuant to new grounds of rejection presented in this Office action.

CONCLUSION

4. Any response to this action should be mailed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703)305-7687 (for formal communications EXPEDITED PROCEDURE) or

(703) 305-7687 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

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Seventh Floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER


John L. Young

Primary Patent Examiner

August 4, 2004